

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 18-21, and 23-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hughes, Jr. U.S. Patent 3,753,312 in view of Fogarty et al U.S. Patent 5,186,673.

Hughes, Jr. disclosed a step of providing a doll (10) having a torso with a waist as shown in Fig. 1; a piece (18, 22) of self-adherent elastic wrappable material (see col. 2, lines 28-37) having opposite sides, and a width, length, and relatively uniform thickness as shown in Fig. 2, the piece being self-adherent between substantially any two portions of the piece as explained in col. 2, lines 28-37; the piece (18, 22) is wrapped around a portion of the doll; the piece is secured to the doll by pressing the piece to the doll body with the vinyl sheet of the piece in contact with the doll, thereby bonding the piece to the doll (col. 2, lines 38-47). The piece (18, 22) is removable (col. 3, lines 27-29). It is noted that Hughes, Jr. failed to teach the step of overlapping two portions of the piece (18, 22) together as set forth in claim 18. However, Fogarty et al disclosed a step of providing a doll, providing a piece of simulated clothing (10), and securing the piece of simulated clothing (10) to the doll by overlapping and together two portions of the piece as shown in Figs. 1 and 2. Therefore, it would have been obvious to one of ordinary skill in the art to modify the teachings of Hughes, Jr. with the step of

providing the piece of simulated clothing with two portions and overlapping the portions together to achieve the predictable results of allowing the user to adjust the piece of simulated clothing to fit neatly over the doll.

Regarding various forms of clothing pieces as recited in claims 24, 25, 30, and 31; such features are merely obvious variations of the pieces of simulated clothing to enhance the aesthetic appearance of the doll. Therefore, it would have been a matter of design choice to provide additional pieces of accessories with the same material as the piece (18, 22) to dress different parts of the doll.

Response to Arguments

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the doll body of Hughes is a two-dimensional body) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). It is noted that the limitation "a doll or a doll-sized or dress form shaped mannequin" does not mean that the doll has a three-dimensional body. The doll of Hughes has a three-dimensional head and two dimensional-bodies which is more than sufficient to meet the claimed invention.

In response to applicant's argument that the clothing items of Hughes are not "realistic" and not "configurable", such arguments are not persuasive because whether the clothing items of Hughes are realistic or not is a matter of opinion and depends on the perception of an individual. Regarding the "configurable" issue, the fact that the

clothing items of Hughes are wrapped around the doll and being removable are sufficient to characterize the clothing items of Hughes are configurable.

In response to applicant's argument that the two dimensional vinyl clothing pieces of Hughes are neither elastic nor wrappable, such argument is not persuasive because applicant failed to address the pieces (18, 22) of Hughes of self-adherent elastic wrappable material as disclosed on column 2, lines 28-37.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the claimed invention does not require the doll and clothing articles as being three dimensional. Therefore, it is proper to combine Hughes and Fogarty to meet the claimed invention for the reason as set forth above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KIEN T. NGUYEN whose telephone number is (571)272-4428. The examiner can normally be reached on 7:30 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kien. T. Nguyen/
Primary Examiner
Art Unit 3711

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